



26 JUL 2006

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OSHA LIANG L.L.P.
1221 McKinney Street
Suite 2800
Houston, TX 77010

In re Application of :
DAUVOIS, Jean-Luc :
U.S. Application No.: 10/538,725 :
PCT No.: PCT/FR03/50181 :
Int. Filing Date: 16 December 2003 :
Priority Date: 17 December 2002 :
Attorney Docket No.: 11354/091001 :
For: METHOD FOR ACCESS CONTROL IN :
DIGITAL PAY TELEVISION :

DECISION

This decision is in response to the "Petition Under 37 CFR § 1.47(b)" filed with the United States Designated/Elected Office (DO/EO/US) on 07 July 2006.

BACKGROUND

On 08 December 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b), and a \$130.00 surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 07 July 2006, applicants filed the subject petition which was accompanied by, inter alia, the \$200.00 petition fee; a five-month extension and \$2,160.00 fee; a declaration signed by the 37 CFR 1.47(b) applicant; a "Declaration by Frederique Dersoir"; a "Certificate of Employment"; and various other documentary evidence.

DISCUSSION

The 37 CFR 1.47(b) applicant claims that the sole inventor in the above-captioned application is uncooperative. The petitioner filed the subject petition pursuant to 37 CFR 1.47(b) as a response to the Form PCT/DO/EO/905 mailed 28 July 2004. A five-month extension and fee were submitted with the petition.

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and

on behalf of the nonsigning joint inventor (5) evidence showing sufficient proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Concerning item (1), the \$200.00 petition fee has been paid.

With regards to item (4), the 37 CFR 1.47(b) applicant submitted a declaration on behalf of the nonsigning inventors. The declaration was signed by the CEO for the 37 CFR 1.47(b) applicant. A chief executive officer is presumed to have authority to sign on behalf of the organization. See MPEP § 324. A review of the declaration shows that it is in compliance with 37 CFR 1.497(a) and (b).

Regarding item (6), the 37 CFR 1.47(b) applicant states that filing this petition "is necessary to preserve the right of the Applicant. This statement satisfies item (6).

Hence, items (1), (4) and (6) of 37 CFR 1.47(b) are complete.

Regarding item (2), petitioner submitted a declaration by Mr. Dersoir who states that a letter was sent to the last known address of Mr. Dauvois on 13 July 2005. The package included a declaration and an assignment for the subject application. However, no one at this address claimed the letter. A second letter was sent on 27 January 2006 with the same results. Finally, an email was sent to Mr. Dauvois last known personal email address. No response was received. Petitioner claims that the declaration by Mr. Dersoir establishes that Mr. Dauvois is "uncooperative."

This conclusion is rejected. Petitioner has provided no evidence that Mr. Dauvois received any of these documents. Not claiming mail addressed to another person is not a refusal. Petitioner must first verify the address for Mr. Dauvois before a refusal on conduct, *i.e.*, not accepting mail, can be accepted. If Mr. Dauvois is unable to be located, the procedures outlined in section 409.03(d) of the MPEP regarding "Inventor Cannot Be Reached" must be followed. For this reason, item (2) is not satisfied.

With regards to item (3), the last known address of the nonsigning joint inventor, Jean-Luc Dauvois is given in the petition as:

80 rue des Victimes du Nazisme
Le Mans 72000
France

However, the declaration signed by Mr. Jan Steven Mes lists the address of Mr. Dauvois as:

19 rue Eugene Manuel
75116 Paris

France

To satisfy item (3), petitioner must clarify the last known address of Mr. Dauvois with their renewed petition.

With regards to item (5), petitioner claims sufficient propriety interest in the above-captioned application due to fact that Mr. Davois was employed with Canal+Technologies from 17 July 1995 to 06 September 2002 and THOMSON acquired the rights from Canal+Technologies. A copy of a "Certificate of Employment" from Canal+Technologies was the only documentary evidence submitted.

This is insufficient. Section 409.03(f) of the MPEP discusses proof of proprietary interest and states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she

otherwise has a sufficient proprietary interest in the matter . . .

Petitioner has not provided a copy of the employment agreement of Mr. Davois with Canal+Technologies, or the required statement of facts by a person having firsthand knowledge that the invention was made by Mr. Davois while employed by Canal+Technologies and that the invention was within the scope of his employment duties. Moreover, petitioner claims that THOMSON acquired the rights for the subject application from Canal+Technologies but has not provided any evidence of this acquisition. This is required.

For these reasons, petitioner has not shown sufficient proprietary interest in the subject application. Item (5) is also not yet satisfied.

CONCLUSION

For the reasons discussed above, applicants' petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302